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SERIAL NUMBER 102/646,529	FILING DATE 05/07/96	FIRST NAMED APPLICANT WOLF INBARGER JR.	ATTORNEY DOCKET NO. L 152.116/SHK
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33M1/0114

EXAMINER	
BLYVEIS, D	
ART UNIT	PAPER NUMBER
3306	#10

DATE MAILED: 01/14/98

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Office Action Summary	Application No. 08/646,520	Applicant(s) Wolfinbarger
	Examiner Deborah Blyveis	Group Art Unit 3306

Responsive to communication(s) filed on Dec 3, 1997.

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 10-18 and 28-49 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 10-18 and 28-49 is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit:

DETAILED ACTION

1. The declaration filed on 12/3/97 under 37 CFR 1.131 has been considered but is ineffective to overcome the '662 reference.
2. The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the '662 reference. Applicant sets forth in the declaration that his invention was reduced to practice before the filing date of the '662 reference, however, the declaration does not provide evidence of this fact. The claims refer to "negative pressure," but the notebook page, Exhibit A, refers to "positive pressure." Furthermore, the graphs refers to protein v. volume, and does not mention pressure.

Please note that description of Exhibit B and Exhibit C given in the Declaration does not correspond to what is contained in the actual exhibit.

3. Please note that the declaration applies only to claims 47, 48, 49 and 10-18, since claims 1-9 and 19-27 have been canceled.

Response to Arguments

4. Applicant's arguments filed 12/3/97 have been fully considered but they are not persuasive. Webster's II New Riverside University Dictionary defines "flow" as "to move freely like a fluid" or "to discharge in a stream." These definitions can refer to air which can move freely or be discharged in a stream. The Examiner uses the broadest definition.

Art Unit:

Furthermore, in the Abstract, Morse discloses a method in which a negative pressure is applied to the bone at the same time as a decontaminating agent or detergent.

Claim Rejections - 35 USC § 112

5. Claims 10-13 and 46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 10-13 depend from claim 50, and there is no claim 50.

In claim 46, there is no antecedent basis for “said waste.”

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. Claims 10-15, 17-18, and 47-49 are rejected under 35 U.S.C. 102(e) as being anticipated by Morse ('662').

Art Unit:

Morse et al. discloses a method whereby negative pressure is applied in a vacuum at less than atmospheric pressure to remove bone marrow, see ex. 7, 8 and abstract. This method decreases initial viral and bacterial particles by applying a bacteriocidal and viricidal agent.

Double Patenting

8. As discussed with Susanne Hopkins on the telephone, a terminal disclaimer is required because 08/646,519 has been issued first.

9. The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 10-18 and 28-49 are provisionally rejected under the judicially created doctrine of double patenting over claims 1, 3-4, 6-12, and 14-29 of copending Application No. 646,519. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

Art Unit:

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: sonicating the bone.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

Art Unit:

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Blyveis whose telephone number is (703) 308-2110.



CORRINE M. McDERMOTT
PRIMARY EXAMINER
GROUP 3300

d.b. DB 1/13/98

January 13, 1998